

Application No. 09/683,200

### REMARKS

The Office Action of May 25, 2005 has been carefully considered. Reconsideration of this application, as amended, is respectfully requested. Claims 1-14 and 16-21 are pending in this application. Of these, claims 1, 18, and 20 are independent claims.

In the specification, this Amendment corrects adds patent numbers that were not known at the time of filing.

In claims, this Amendment amends claims 1, 2, 16, 18 and 20, cancels claim 15, and adds new claim 21. More specifically, claims 1, 18, and 20 were amended to incorporate the limitations of now canceled claim 15; in addition claim 20 was amended to incorporate limitations in paragraphs 0054-0056 describing Figure 4 of Applicant's specification; claim 16 was amended to refer to claim 1 and to correct a typographical error; and new claim 21 was added to include similar limitations recited in claim 15. No new matter is therefore believed to be introduced by these amendments.

#### 1. Response to Rejection Under 35 USC 112

The Office Action in section 4, on page 2, rejects claim 2 under 35 USC 112, second paragraph, as being indefinite in that "command data" is recited with insufficient antecedent basis. In response thereto, Applicant amends claim 2 to specify that image data is modified in accordance with "annotations" defined in claim 1. Support for this amendment is set forth in paragraph 0007 of Applicant's specification. No new matter is therefore believed to be introduced by this amendment. Accordingly, this rejection is now believed to be overcome.

#### 2. Response to Rejection Under 35 USC 103

The Office Action in section 6, on pages 3-6, rejects claims 1, 2, 3, 7, 10, 11-17, and 18-20 under 35 USC 103(a) as being unpatentable over Hou, U.S. Patent No. 6,546,152 (hereinafter referred to as "Hou") in view of Telle, U.S. Patent No. 5,555,099 (hereinafter referred to as "Telle").

In response thereto, Applicant amends independent claims 1, 18, and 20 to more clearly set forth Applicant's invention by incorporating the limitations of dependent claim

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15. Applicant respectfully submits that the combination of claim 1 and the limitations of claim 15 are not disclose or suggested by Hou taken singly or in combination with Telle as alleged in the Office Action on page 6, lines 3-5.

More specifically, the cited sections in the Office Action of column 3 and 5 of Hou taken singly or together with the cited sections in the Office Action of column 4 of Telle fail to disclose or suggest Applicant's invention recited in amended claim 1 of an interactive document processing system that identifies annotations in signal data from an input device by comparing the signal data with image data of a rendered hardcopy document, where a memory records the image data of a rendered hardcopy document together with an identifier that is associated with the image data, where the identifier and the image data are recorded in the memory *in response* to rendering the hardcopy representation of the image data.

In contrast, Hou discloses a method for scanning a series of images of a document and identifying when the images overlap (see Hou col. 2, lines 9-27, col. 4, lines 12-16), while Telle enables page level annotation of a print job (see Telle col. 4, lines 24-34). Accordingly, Applicant respectfully submits that independent claim 1 as amended is patentably distinguishable over Hou taken singly or in combination with Telle.

In addition, it should be noted that independent claims 18 and 20 contain very similar limitations to those discussed above with respect to claim 1, and therefore the argument presented above with regard to claim 1 applies equally to independent claims 18 and 20. Insofar as claims 2, 3, 7, 10, 11-14, 16-17, 19 and 21 are concerned, these claims depend from one of now presumably allowable independent claims 1 and 18 and are also believed to be in allowable condition.

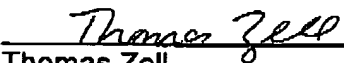
Also, the Office Action in section 7, on pages 6-8, rejects claims 4-6, 8, and 9 as being unpatentable over Hou in view of Telle and further in view of Wolff et al., UK Patent Application GB 2 306 669. The merits of the rejection of claims 4-6, 8, and 9 need not be specifically addressed herein because these claims depend from claim 1 which is now believed to be patentable for those reasons set forth above.

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### 3. Conclusion

In view of the foregoing remarks, reconsideration of this application and allowance thereof are earnestly solicited. In the event the Examiner considers a personal contact advantageous to the disposition of this case, the Examiner is hereby requested to call Attorney for Applicant(s), Thomas Zell.

Respectfully submitted,

  
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